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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/786,336	06/13/2001	Garri Kimovich Kasparov	204271US2PCT	5069

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ALEXANDRIA, VA 22314

EXAMINER

MARKS, CHRISTINA M

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 06/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/786,336

Applicant(s)

KASPAROV ET AL.

Examiner

C. Marks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 36-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 April 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 14 April 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Priority***

In further consideration of the arguments presented by the Applicant in the amendment filed 14 April 2003, the objection to the claim for priority has been withdrawn.

### ***Specification***

The specification is objected to for the multiple inclusions of << >> around words (for example see pages 1, 7, 11, 14, among others). Applicant is required properly correct the inclusion of << >> in response to this Office Action.

### ***Drawings***

The objections to the drawings for not showing adequate detail in relation to the flowcharts and figures incorporating only numbers has been withdrawn due to the proposed drawing correction filed 14 April 2003.

The drawings are objected to under 37 CFR 1.83(a) because they fail to show the equations to compute different variables as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d).

Further, the drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the method in which the variables are obtained must be shown or the feature(s) canceled from the claim(s). No new

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matter should be entered. Further, there appears to not even be a reference to f1 or t1 in the drawings.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The rejection of claims 1-35 under 35 U.S.C. first and second paragraph has been hereby withdrawn due to the cancellation of the claims in the amendment filed 14 April 2003.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 36-51 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claim 36 and those dependent therefrom, the definitions of the variables claimed are not adequately supported in the specification in such a way to enable one of ordinary skill in the art to make or use the invention. For example:

1) N is loosely defined as data from the timer (page 15, line 14) and the specific data is not mentioned

2) T1 is defined as data of time measuring means (page 16, line 35) and the exact data and how it was obtained is not disclosed

3) f1 and f2 is defined to be the reading of a predetermined frequency (page 17) wherein how the frequency was based is not disclosed

4) T2 is defined as data of time measuring means (page 17, line 13) and the exact purpose and function of the data and how it was obtained is not disclosed

5) t1 and t2 are defined as temporal parameters after a determined time period (page 17) wherein the time period or how the time period is determined is not disclosed and are defined only as the beginning and end of an event.

These definitions of these variables are not described in a way that one of ordinary skill in the art would be enabled to use them or be able to understand their purpose in relation to the claimed invention. Their definitions do not distinctly disclose that which they are, nor do they serve to adequately describe their purpose as a relation to the timing as a whole. Further, the method steps of reading, storing, recording, and determining are also not adequately enabled.

Regarding claim 37-43, as disclosed above, one of ordinary skill in the art would not be able to ascertain that which is being measured by the variables and therefore the calculation involving the variables are not adequately disclosed in the specification to enable one of ordinary skill in the art to make or use the invention.

Further regarding claim 47 and those dependent therefrom, though a game area is mentioned in the specification, there is not adequate support for forming a game area. The step

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of forming a game area is not enabled in such a manner to allow one of ordinary skill in the art to make or use the invention.

Claims 37-54 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 37, the equation claimed is disclosed in the specification to be equal to  $T_2$  (page 17, line 11), not  $T$  as claimed, thus the equation represents new matter as one of ordinary skill in the art would not be able to determine if it is indeed what was meant to be disclosed by the specification.

Regarding claim 38, the equation claimed is disclosed in the specification to be equal to  $T_1$  (page 16, line 34), not  $T$  as claimed. Further, the values of  $N_1$  and  $N_i$  have been reversed when viewed in light of the specification, thus the equation represents new matter, as one of ordinary skill in the art would not be able to determine if it is indeed what was meant to be disclosed by the specification.

Regarding claim 39, the equation claimed is disclosed in the specification to be equal to  $T_2$  (page 17, line 11), not  $T$  as claimed, thus the equation represents new matter as one of ordinary skill in the art would not be able to determine if it is indeed what was meant to be disclosed by the specification.

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Regarding claim 40, the equation claimed is disclosed in the specification to be equal to  $T1$  (page 16, line 34), not  $T$  as claimed. Further, the values of  $N1$  and  $Ni$  have been reversed when viewed in light of the specification, thus the equation represents new matter, as one of ordinary skill in the art would not be able to determine if it is indeed what was meant to be disclosed by the specification.

Regarding claims 41 and 42, the equations relating to the defined value of  $f2$  and  $t2$  do not appear to be disclosed in the specification.

Regarding claim 43,  $Y$  is defined in the specification as a computation error and claimed as an error correction term. Further, the equation relating to the value of  $Y$  does not appear to be disclosed in the specification.

Regarding claim 44, it does not appear to be disclosed in the specification that the first timing data comprises a code number of a timer.

Regarding claim 45 and those dependent therefrom, it does not appear to be disclosed in the specification that the first timing data comprises storing information relating to a drawing version wherein a drawing version comprises at least one of an event code or monetary stake.

Regarding claim 46, it does not appear to be disclosed in the specification that the device checks the correctness of the information and if the information is incorrect, generating a signal for prohibiting recording of said incorrect information in memory.

Regarding claim 49, it does not appear to be disclosed in the specification that the game area corresponds to a roulette game.

Regarding claim 50, it does not appear to be disclosed in the specification that the game area can correspond to a code of a lottery event.



Regarding claim 51, it does not appear to be disclosed in the specification that true information and conditions for determining a win can be input into the memory device. Likewise, true information and conditions does not appear to be disclosed or defined.

Regarding claim 52 and those dependent therefrom, there does not appear to be disclosed in the specification a time-characteristics measuring device or one such that is separate from the timer.

Furthermore, due to the new matter regarding the above named limitations, these limitations are also rejected under 35 U.S.C. 112, first paragraph, as non-enabling as they are not originally defined in the specification; therefore, the usage of the terms and limitations is not done so in a manner that would enable one of ordinary skill in the art to make or use the invention.

Applicant is invited to point out support regarding the new matter/enablement if the support does indeed exist.

Claims 36-51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 36 and those dependent therefrom, the variables used are indefinite as one of ordinary skill in the art would not be able to ascertain the relationship among them, as there are no disclosed ranges or a defined relative start point. There is not distinction about how the first set is related to or differs from the said second set or how the timing is associated with and in relationship to all the variables. Therefore, one of ordinary skill in the art would not understand what is meant by the limitations involving them and thus their inclusion is indefinite.

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Further, the method steps of reading, storing, recording, and determining are also indefinite as one of ordinary skill in the art would not be able to ascertain that which is being read, stored, recorded or determined at these steps.

Regarding claim 37-43, as disclosed about, one of ordinary skill in the art would not be able to ascertain that which is being measured by the variables and therefore the calculation involving the variables is indefinite.

Further, regarding claims 37-43, the equations cited do not match up with the equations supported by the disclosure as detailed below and are thus indefinite to one of ordinary skill in the art.

Regarding claim 37, the equation claimed is disclosed in the specification to be equal to  $T_2$  (page 17, line 11), not  $T$  as claimed, thus the equation represents new matter as one of ordinary skill in the art would not be able to determine if it is indeed what was meant to be disclosed by the specification.

Regarding claim 38, the equation claimed is disclosed in the specification to be equal to  $T_1$  (page 16, line 34), not  $T$  as claimed. Further, the values of  $N_1$  and  $N_i$  have been reversed when viewed in light of the specification, thus the equation represents new matter, as one of ordinary skill in the art would not be able to determine if it is indeed what was meant to be disclosed by the specification.

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Regarding claim 40, the equation claimed is disclosed in the specification to be equal to  $T1$  (page 16, line 34), not  $T$  as claimed. Further, the values of  $N1$  and  $Ni$  have been reversed when viewed in light of the specification, thus the equation represents new matter, as one of ordinary skill in the art would not be able to determine if it is indeed what was meant to be disclosed by the specification.

Regarding claim 43,  $Y$  is defined in the specification as a computation error and claimed as an error correction term. Further, the equation relating to the value of  $Y$  does not appear to be disclosed in the specification.

Therefore for the reasons disclosed above and for examination purposes, the claims will be examined as best understood by the Examiner.

***Claim Rejections - 35 USC § 102***

The rejection of claims 1-35 under 35 U.S.C. 102(b) as being clearly anticipated by Kasparov et al. (WO 00/13757) has hereby been withdrawn due to the grant of priority and the cancellation of these claims by the amendment filed 14 April 2003.

Further, the rejection of claims 1, 11, 17, 18, and 22 under 35 U.S.C. 102(b) as being anticipated by Libby et al. (US Patent No. 5,722,890) has been hereby withdrawn due to the cancellation of the claims by the amendment filed 14 April 2003.

***Claim Rejections - 35 USC § 103***

The rejection of claims 19-21 and 24 under 35 U.S.C. as being unpatentable over Libby et al. (US Patent No. 5,722,890) in view of Bolan (US Patent No. RE 32,480) has been withdrawn due to the cancellation of the claims by the amendment filed 14 April 2003.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 36-54, as best possibly understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Fascenda et al. (US Patent No. 4,592,546).

Fascenda et al. disclose a method of conducting a lottery wherein a user has a portable memory device (FIG 1) with the memory device having an input (FIG 1, reference 12) and output (FIG 1, reference 16) unit, a timer (Column 3, lines 7-8), and a memory configured to store the timing data (Column 3, lines 10-20). The device is in communication with a data collection unit such that the timing data stored in the memory device can be read by the collection computer (Column 3, lines 15-20). Fascenda et al. also disclose the use of a count associated with a number of counters and serve as real time clocks to keep time data (Column 3, lines 10-20). The count starts at a time prior to the user inputting lottery information. This information is associated with a first count representing the time it was input by the user and a second count to make sure it was input before the deadline (Columns 5, lines 18-60). In this manner, the device of Fascenda et al. is storing count data relating to the input of the user and the time in which the user input the information. The time of entry and time of actual event is stored (Column 3, lines 53-58). As a number of inputs are used, it is notoriously well known in the art

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that frequencies and periods could thus be garnished. The same feature applies to second and subsequent times including the time in which the play actually happened throughout the life of the event (Column 1, lines 62-64).

Regarding claims 37-43, as best possibly understood by one of ordinary skill in the art, it would have been obvious to use the data stored in relation to the timing of events as disclosed by Fascenda et al. to make further computations involving the timing, frequency, period, and error associated with these calculations, as such computations involving establishing other data relating to timing from variables already acquired is notoriously well known in the art and thus would have been obvious to one of ordinary skill in the art at the time of invention.

Regarding claim 44, as best understood, the timers have counters that store verification codes associated with the timer in order to help prevent cheating (Abstract).

Regarding claim 45, as best understood, Fascenda et al. do not explicitly disclose storing information relating to the drawing version; however, each prediction is in essence its own drawing and information event codes according to the play that actually happened are stored in order to provide comparison to user input (Column 4, lines 1-15).

Regarding claim 46, as best understood, Fascenda et al. discloses checking the correctness of the information in the matter of checking to make sure it was entered within the correct time period. If the information was not entered within the correct time period and thus is incorrect, it will not be recorded or entered into the system (Column 3, lines 53-65).

Regarding claim 47, as best understood, the method of Fascenda et al. is related to a game area corresponding to a lottery event, as players wager to on a selection of a plurality of possibilities that can occur in the future (Column 2, lines 57-58).

Regarding claims 48 and 49, as best understood, the type of lottery game used in respect to Bingo or Roulette would have been obvious to one of ordinary skill in the art as both are notoriously well known in the art as games wherein the participant can predict a future variable of an event up to a time before the event actually occurs, which is the same format disclosed by Fascenda et al.

Regarding claim 50, as best understood, Fascenda et al. discloses that many predictions can be made throughout the life of the event (Column 1, lines 59-62). It would be axiomatic to the method when the game is started a code identifying such a start time is created. This code is also disclosed in the form of a snap time that indicates the start of each prediction part of the lottery event (Column 3, lines 50-60).

Regarding claim 51, as best understood, the user can input what they believe to be true information and this information is compared to the actual true information in order to determine a win (Column 4, lines 1-3).

Regarding claim 52, as best understood, the system of Fascenda et al. discloses an information source linking participants to a lottery over a communication channel (FIG 1). This portable memory source includes an input (FIG 1, reference 12), an output (FIG 1, reference 16), a memory (FIG 2, reference 26), a control unit (FIG 2, reference 23) and is configured to record lottery information input by a participant (Column 2, line 37). The system also includes a data collection computer that has an I/O unit (Column 3, lines 25-40) and receives and input from the portable device including a recording of the time of input through the receipt of the counters (Column 3, lines 25-42). The system also includes a time measuring device (Column 3, lines 10-20) connected to the real time timer of the portable device (Column 3, lines 10-20) to establish a

time of entry based upon the time-characteristic measuring device and the timer and then output to the data collection computer (Column 3, lines 25-42).

Regarding claims 53 and 54, as best understood, because the time characteristics measuring device is connected to the real time clock, it inherently possesses a frequency meter and also an oscillator as it is notoriously well known in the art that a clock is in a continuous oscillation of cycles in order to keep track of the time that has passed.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**US Patent No. 5,936,661:** Interactive game where viewers can compete with studio audiences and a timer is enclosed to make sure transmissions occur within the selected time.

**US Patent No. 6,514,084:** User input where a plurality of timers are used to keep track of different times between answers and times between other information and presentation.

**US Patent No. 5,526,035:** Interactive television system wherein use can go from event to event and wherein a player can achieve scores for their answer.

**US Patent No. 6,287,199:** Predict the Play game wherein the user can interact with a live event and predict information to be true and must do so before certain timing constraints.

**US Patent No. 5,326,104:** Automated casino game wherein the player can pick associated keno numbers and must do so before a certain time.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael O'Neill, Acting SPE, can be reached on (703)-308-3484. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9302 for regular communications and (703)-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1148.

*cmm*  
cmm  
June 19, 2003

*Michael O'Neill*  
**MICHAEL O'NEILL**  
**PRIMARY EXAMINER**